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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,962	10/07/2003	Shlomo Touboul	FIN0006-US	6073
74877 7590 01/05/2009 King and Spalding LLP 1700 Pennsylvania Ave, NW Suite 200 Washington, DC 20006				
EXAMINER				
ANWARI, MACEEH				
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2444				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/680,962

Applicant(s)

TOUBOUL ET AL.

Examiner

MACEEH ANWARI

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1- 36, 38-57, 59, 61-67, 69-76, 78- 83 and 85-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1- 36, 38-57, 59, 61-67, 69-76, 78- 83 and 85-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to communications file on 11/25/2008. **Claim(s) 1, 13, 15, 19, 29, 32- 34, 38, 42-44, 48, 52-54, 59, 67, 76 and 83** have been amended. **Claim(s) 60, 68, 77 and 84** have been canceled. No other claims have been amended, added, or canceled. Accordingly, **claim(s) 1- 36, 38-57, 59, 61-67, 69-76, 78- 83 and 85-89** are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2008 has been entered.

Response to Arguments

1. Applicant's arguments with respect to **claims 1- 36, 38-57, 59, 61-67, 69-76, 78- 83 and 85-89** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1- 36, 38-57, 59, 61-67, 69-76, 78- 83 and 85-89** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the applicant intends the control mark to remain unchanged or the static section of the electronic document while the electronic document is edited by a document editor. The examiner will interpret the claim(s) as the static section of the electronic document to remain unchanged.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 8-16; 19, 26-36, 38-47, 48- 57, 59, 61-66, 67, 69-74, 76, 78-82, 83 and 85-89** rejected under 35 U.S.C. 103(a) as being unpatentable over **Tsuji et al.** (hereinafter **Tsuji**; **U.S. Patent No.: 5,764,898**) and further in view of **Ahern (U.S. patent No.: 6,769,061 B1)**.

6. Regarding **claim 1**, **Tsuji** discloses a method for tracking the routing of an electronic document, comprising:

monitoring e-mail messages transmitted from senders to recipients, for detection of e-mail messages having the electronic document embedded therewithin or attached thereto, based on the unique identifier (**Figures 1, 3-5 & 8 and Abstract & Col. 3 lines 1-10; task tracking unit, tracking object, and transmitted mail**).

However, **Tsuji** remains silent on the specific teachings of embedding a control mark, including a unique identifier and an encrypted check sum for authenticating the unique identifier, within a static section of an electronic document, wherein the static section remains unchanged when the electronic document is edited by a document editor.

In the same field of endeavor, **Ahern** discloses embedding a control mark [**Ahern: 110, 221**], including a unique identifier [**Ahern: 141A**] and an encrypted check sum for authenticating the unique identifier [**Ahern: 131**], within a static section of an electronic document, wherein the static section remains unchanged when the electronic document is edited by a document editor (**Ahern: Figures 1& 2 and Abstract and Col. 2 lines 4- 24, Col. 5 lines 36- 62; wartermark generator, private key, checksum and white space**).

Accordingly it would have been obvious for one of ordinary skill in the networking art to modify or incorporate **Ahern's** teachings of adding a digital wartermarking, a private key and a checksum parameter with the teachings of **Tsuji's** tracking and monitoring of e-mails to provide for a more reliable and efficient system for verification of electronic documents (**Col. 2 lines 26-33**).

7. Regarding **claim 8, Tsuji-Ahern** further discloses comprising logging a recipient of an e-mail message having the electronic document embedded therewithin or attached thereto, in an audit record, when said monitoring detects the e-mail message wherein the audit record stores information identifying a

distribution route of the electronic document (**Figures 1, 3-5 & 8 and Abstract & Col. 3 lines 11-25; control information unit, and log information**).

8. Regarding **claim 9, Tsuji-Ahern** further discloses comprising logging a sender of an e-mail message having the electronic document embedded therewithin or attached thereto, in an audit record, when said monitoring detects the e-mail message wherein the audit record stores information identifying a distribution route of the electronic document (**Figures 1, 3-10 and Abstract & Col. 3 lines 11-25; control information unit, and log information**).

9. Regarding **claim 10, Tsuji-Ahern** further discloses comprising logging a date and time of transmission of an e-mail message having the electronic document embedded therewithin or attached thereto, in an audit record, when said monitoring detects the e-mail message, wherein the audit record stores information identifying a distribution route of the electronic document (**Figures 1, 3 & 7 and Col. 2 lines 31-45 & Col. 3 lines 11- 25; log information, control information, deadlines and processing records**).

10. Regarding **claim 11, Tsuji-Ahern** further discloses comprising generating a tracking report from audit records, corresponding to at least one specified electronic document wherein the audit record stores information identifying a distribution route of the electronic document (**Figures 1, 3-10 and Abstract & Col. 3 lines 11-25; control information unit, and log information**).

11. Regarding **claim 12, Tsuji-Ahern** further discloses comprising generating a tracking report from audit records corresponding to at least one specified user,

wherein the audit records each stores information identifying a distribution route of an electronic document (**Figures 1, 3 & 7 and Col. 2 lines 31-45 & Col. 3 lines 11-25; log information, control information, deadlines and processing records**).

12. Regarding **claim 13, Tsuji-Ahern** further discloses comprising generating a tracking report from the audit records, corresponding to a specified time period wherein the audit record stores information identifying a distribution route of the electronic document (**Figures 1, 3-10 and Abstract & Col. 2 lines 36-67; control information unit, log information, fixed time interval and deadlines**).

13. Regarding **claim 14, Tsuji-Ahern** further discloses logging the most recent file name of a file storing the electronic document, in an audit record, when said monitoring detects an e-mail message having the electronic document embedded therewithin or attached thereto wherein the audit record stores information identifying a distribution route of the electronic document (**Figures 1, 3-10 and Abstract & Col. 2 lines 36-67; control information unit, log information, fixed time interval and deadlines for processing of received mail**).

14. Regarding **claim 15, Tsuji-Ahern** further discloses wherein said monitoring comprises authenticating the unique identifier using the encrypted checksum (**Ahern: Figures 1& 2 and Abstract and Col. 2 lines 4- 24, Col. 5 lines 36- 62; wartermark generator, private key, checksum and white space**).

15. Regarding **claim 16, Tsuji-Ahern** further discloses comprising issuing a notification if said authenticating fails to authenticate the unique identifier (**Figures 1 & 3-10 and Abstract & Col. 6 lines 5-17 and lines 34-39; authorized user, issuing warnings**).

Claims 38-47, 48-57, 59,61-66, 67, 69-74, 76, 78-82, 83 and 85-89 all list the same limitations as in **claims 1, 8-16** and are therefore rejected using the same rationale.

16. **Claims 2-7 and 20-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tsuji**, as applied above, and further in view of **Scheier et al.** (hereinafter **Scheier**) U.S. Publication No.: **2002/0035584 A1**.

Tsuji teaches the invention as discussed above.

Tsuji does not appear to explicitly disclose wherein "the electronic document is a Microsoft word document (or Microsoft Excel spreadsheet or Microsoft PowerPoint presentation or Adobe PDF document or HTML document or XML document)."

Scheier teaches, "the electronic document is a Microsoft word document (or Microsoft Excel spreadsheet or Microsoft PowerPoint presentation or Adobe PDF document or HTML document or XML document)" as "data retrieval system where the data is returned in formatted text, comma separated values, Word, Excel, PDF and other common formats." (**Paragraph 175**)

Tsuji and **Scheier** are analogous art because they are from the same field of endeavor of managing and controlling internet based transactions and e-mail.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of **Tsuji** and **Scheier** before him or her, to incorporate monitoring electronic mail messages from senders to recipients, as disclosed in **Tsuji**, with the ability to track and send the various formats of data, as disclosed within **Scheier**.

The motivation for doing so would have been to more efficiently manage and control various forms of electronic documents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the present invention to combine **Tsuji** with **Scheier** to obtain the invention as specified in the instant claims.

17. **Claims 17-18, 35-36, 59, 67 and 83** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tsuji**, as applied above, and further in view of **Salzfass et al.** (hereinafter **Salzfass**) U.S. Publication No.: **2002/0042815 A1**.

Tsuji teaches the invention as discussed above.

Tsuji also teaches, authenticating and allowing permission to transmit the electronic document to a recipient of and e-mail message (**Figures 1 & 3-10 and Abstract & Col. 4 lines 36-42 & Col. 6 lines 34-39; authorized user, control information memory unit, user interface unit, prompting and warning messages**).

Tsuji does not explicitly disclose wherein blocking the transmission of an e-mail message to a recipient if permission is not granted and issuing a notification about the blocking.

However, **Salzfass** discloses sending a notification message directly to the sender's e-mail address advising him that the intended recipient has set a filter to block certain e-mails (**Figures 2-3 and Par. 62**).

Tsuji and **Salzfass** are analogous art because they both focus on managing and controlling electronic documents (i.e. e-mails).

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of **Tsuji** and **Salzfass** before him or her, to incorporate an e-mail filter for blocking certain e-mails, as disclosed by **Salzfass**, with an access control policy, as disclosed by **Tsuji**.

The motivation for doing so would have been to facilitate a more efficient, safe and through management of monitoring e-mail(s).

(Claim objections → Claim Rejections)

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. **Nassiri (U.S. Pub: 2002/0046250 A1)**, directed towards a certified and registered electronic mail system.
- b. **Matsuura et al. (U.S. Pub: 2002/0044294 A1)**, directed towards providing information to a user using an electronic mail system.
- c. **Barra et al. (U.S. Pub: 2002/0104026 A1)**, directed towards electronic mail communications with sender and/or recipient confirmation of delivery.

- d. **Stolfo et al. (U.S. Pub: 2003/0167402 A1)**, directed towards a system and method for detecting malicious e-mail transmission.
- e. **Ng (U.S. Pat: 6,640,301 B1)**, directed towards authentication of e-mail messages.
- f. **Karim (U.S. Pat: 6,654,892 B1)**, directed towards a certified and registered electronic mail system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.
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